

Date Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LVIP:106US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 26, 2005

Signature

Typed or printed C. Paul Maliszewski
name

Application Number

10/604,135

Filed

June 27, 2003

First Named Inventor

LIHL, Reinhard

Art Unit

3724

Examiner

Carolyn T. BLAKE

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. 51,990
Registration number _____ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

C. Paul Maliszewski

Typed or printed name

716-626-1564

Telephone number

August 26, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Attorney Docket No.: LVIP:106US
U.S. Patent Application No. : 10/604,135
Reply to Office Action of June 14, 2005
Date: August 26, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: LIHL, et al.

U.S. Patent Application No.: 10/604,135

For: ILLUMINATION DEVICE FOR
MICROTOMES AND
ULTRAMICROTOMES

Examiner: BLAKE, Carolyn T.

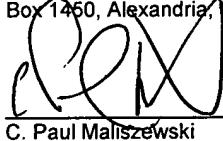
Group Art Unit: 3724

Confirmation No.: 1134

Customer No.: 24041

Certificate of Mailing by First Class Mail

I certify that this correspondence is being deposited on August 26, 2005 with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.



C. Paul Maliszewski

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Honorable Sir:

This Pre-Appeal Brief Request for Review is submitted in response to the Office Action of June 14, 2005 and the Advisory Action of August 8, 2005.

Arguments are provided on page 2 of this paper.

Attorney Docket No.: LVIP:106US
U.S. Patent Application No. : 10/604,135
Reply to Office Action of June 14, 2005
Date: August 26, 2005

Arguments

Rejection of Claims 1, 10, and 11 under 35 U.S.C. §103 (Obviousness)

The Examiner rejected Claims 1, 10, and 11 as being obvious in view of the teachings of German Patent Application No. DE 32 24 375 (Bilek), German Patent Application No. DE 36 15 713 (Wolf), and U.S. Patent Application Publication No. 2003/0024368 (Fukuoka).

Arguments regarding Claim 1:

On page 2 of the Office Action of June 14, 2005 (hereinafter referred to as the Office Action), the Examiner asserted that light source 6 in Bilek acts as the incident illumination source and the internal preparation illumination system recited in Claim 1. The Examiner based the assertion on a definition of “incident” on page 5, lines 17-18. Applicants argued in the second half of page 2 and beginning of page 3 of the Reply of July 27, 2005 (hereinafter referred to as the Reply) that this interpretation was overly broad and was not supported by the facts. That is, the Examiner has committed an error in facts.

In the Response to Arguments in the Reply (page 5-6, item no. 11), the Examiner referred to Figures 3 and 4 of the present application as representing an incident illumination source and an internal preparation illumination system. On page 3 of the Reply (second full paragraph) and page 4 of the Reply (third paragraph), Applicants showed that Figures 3 and 4 are clearly referring to a base-illumination system, not an incident illumination source or an internal preparation illumination system. The Examiner has committed an error in facts by referring to Figures 3 and 4 as representing an incident illumination source and an internal preparation illumination system.

In the Advisory Action of August 8, 2005, the Examiner argued in item #11 that the references teach an equivalent structure, and thus can be applied. The Examiner based this assertion on Figures 3 and 4 of the present application. These figures illustrate a *base-illumination system*, not “an incident illumination source” or “an internal preparation illumination system.” Bilek fails to teach structures equivalent to the incident illumination source or the internal preparation illumination system recited in Claim 1 and shown in Figures 2 and 7, respectively, of the present application. Again, the Examiner has committed an error in

Attorney Docket No.: LVIP:106US
U.S. Patent Application No. : 10/604,135
Reply to Office Action of June 14, 2005
Date: August 26, 2005

facts by referring to Figures 3 and 4 as representing an incident illumination source and an internal preparation illumination system.

On page 2, lines 19-21, of the Office Action, the Examiner stated that Wolf teaches an illuminating system using a light-emitting diode (LED). On page 5, first paragraph, of the Reply, Applicants showed that Wolf actually teaches a proximity sensing arrangement using an LED. The Examiner has committed an error in facts by misrepresenting Wolf's proximity system.

Applicants presented arguments regarding the lack of motivation to select Fukuoka for combination in the Reply of March 16, 2005 (pages 7-8).

The Examiner has failed to provide the elements necessary for a *prima facie* case of obviousness regarding Claim 1. As stated in the arguments regarding Fukuoka, the Examiner has not shown that there is teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one having ordinary skill in the art, to modify the references or combine reference teachings.

Also, the Examiner has not shown that the prior art references (or references when combined), teach or suggest all of the claim limitations. Specifically, the references do not teach or suggest: an incident illumination source, an internal preparation illumination system, or an illuminating system using an LED.

Arguments regarding Claims 10 and 11:

Arguments regarding Claims 10 and 11 are presented on pages 5-6 of the Reply and are substantially based on the arguments regarding Claim 1.

Rejection of Claims 2, 3, and 4 under 35 U.S.C. §103 (Obviousness)

Applicants' arguments regarding the rejections of Claims 2, 3, and 4 are presented on pages 6 and 7 of the Reply. The arguments are based on Claim 1 being patentable over the cited prior art, and the dependency of these claims from Claim 1.

Attorney Docket No.: LVIP:106US
U.S. Patent Application No. : 10/604,135
Reply to Office Action of June 14, 2005
Date: August 26, 2005

Conclusion

For the reasons set forth above, Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564
Fax No. 716-626-0366

CPM/

Dated: August 26, 2005